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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/287,307	04/07/1999	NORMAN K. SPROCH	026SP0342	6152

7590

07/02/2002

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EXAMINER

PHAN, THAI Q

ART UNIT

PAPER NUMBER

2123

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

Office Action Summary

Application No.
09/287,307

Applicant(s)
Norman K. Sproch

Examiner
Thai Phan

Art Unit
2123



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr. 01, 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

This Office Action is in response to applicant's amendment filed Apr. 01, 2002 to the related patent application S/N: 09/287,307. Claims 1-18 are pending in this official action.

Drawings

1. The drawings filed 04/07/99 are objected to by the draftsman (attached PTO Form 948).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Stoughton et al., patent no. 5,965,352.

As per claim 1, Stoughton anticipated method and system for parametrically characterizing a three dimension protein or protein complex surface as claimed (see Abstract, "Background of the Invention"). According to Stoughton, the method includes steps of mixing

protein molecule with molecule for interaction, performing spectroscopic analysis, including known electrospray ionization mass spectrometry, for the mixed molecules, reaction paths, characterizing the molecule structure, and repeating such steps if necessary to obtain a good result of reaction for characterization (“Summary of the Invention”, col. 12, lines 3-9, col. 15, line 54 to col. 16, line 8, col. 19, line 59 to col. 31, line 36).

As per claim 2, Stoughton anticipated computerized data processing system including plurality of means for performing steps as claimed (cols. 31 and 32, “Implementation Systems and Method”). Stoughton also anticipated simulating the model to predict error and to correct the model using feedback loop as claimed.

As per claims 3-6, Stoughton anticipated a variety of proteins and protein complex structures as claimed.

As per claims 7-18, due to the similarities of claims 7-18 to claims 1-6, and further, electrospray ionization mass spectrometry as known in the art would also require calculation of binding constant, heat of formation, heat of reaction, etc for predicting binding of molecules to a selected sites on the large molecule, claims 7-18 are thus rejected under the same rationales as set forth.

Response to Arguments

4. Applicant's arguments filed Apr. 01, 2002 have been fully considered but they are not persuasive.

In response to applicant's argument *Stoughton et al.* ('352) is inapplicable for the rejection of the presently claimed invention which is a continuation-in-part (CIP) of the parent application, filed on Dec. 8, 1995 (page 2), the examiner disagrees with. The present application is a continuation-in-part of the patent application, filed on Apr. 07, 1999 (see application status data). *Stoughton* ('352) used in the related art rejection to the claimed invention has a filing date of May 8, 1998. It's clear *Stoughton* patent has an earlier filing date, and is entitled to 102 (e) of 35 U.S.C. 102.

Applicant need to point out in the remark where the benefit of an earlier application and content of the earlier application fully supported for the present claimed invention.

Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Phan whose telephone number is (703) 305-3812.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:


(703) 746-7238, (for Formal communications; please mark "EXPEDITED PROCEDURE"),

Or:

(703) 746-7239 (for Unofficial Fax communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

June 17, 2002


SAMUEL BRODA, ESQ.
PATENT EXAMINER